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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,573	04/10/2001	Ryuichiro Hisamatsu	450100-03152	7755

20999 7590 10/15/2004

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,573

Applicant(s)

HISAMATSU ET AL. *ST*

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office action is in response to Applicant's RCE, filed on 09/29/2004.
2. Claims 1-22 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargée, Jr. (U.S. Pat. No. 4,422,093) and Stern (U.S. Pat. No. 6,591,247) in view of Brown (U.S. Pat. No. 6,611,842).

**As per claims 1, 3-6, 8, and 10-22, Pargée** substantially discloses a virtual service that employs the full facilities of a satellite television communication channel, comprising the steps of:

obtaining information about earnings and expenses based on expenses incurred by content providers (content providers or satellite television broadcasting, cable television) supplying users with recording devices compatible with contents offered by the providers (see., abstract, col 3, lines 15-30, col 6, lines 18-38). Pargée fails to explicitly

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disclose advertisements and fees included in the contents. However, Stern discloses an advertising and payment method/system to disseminate information concerning multiple products. The advertisements information is associated with various products or contents (see., abstract, col 1, lines 37-67, col 3, lines 12-32, col 4, lines 46-67, it is obvious to recognize that satellite or cable broadcastings provide earnings for service provide to consumers). Therefore, it would have bee obvious to a person of ordinary skill in the art at the time the invention was made to modify the television burst service of Pargee by including the limitations detailed above as taught by Stern because this would advertise consumers in the television industry while ensuring that consumers is ready to perceive the message content of the advertisement.

Pargee and Stern fail to explicitly disclose Applicant's newly added limitation wherein said determining said services and/or advertisements to be provided to said users based on said users viewing history data. Brown discloses a computer system that includes a database storing user histories of selected products. A user profile data that can be utilized to provide targeted advertising and/or to automatically select products are identified with similar underlying characteristics of the user. A television recording apparatus that automatically records television programs based on a correspondence between program profile data associated with the television programs and user profile data that has been generated based on past history of the user's viewing habits (see., abstract, col 1, lines 16-26, col 3, lines 4-30). It would have bee obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of

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Pargee and Stern by including the limitations detailed above as taught by Brown because this would provide data or advertisements which reflect individual preferences.

**As per claims 2, and 9, Pargee** discloses the claimed method wherein said services constitute electronic commerce practiced by virtual shops (see., abstract, specifically wherein it is stated that a virtual service that employs the full facilities of a television communication channel on an intermittent basis, col 3, lines 3, lines 19-67).

**As per claim 7, Pargee** discloses the claim method wherein said recording devices each include a hard disc drive (fig 4, col 7, lines 17-50).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

October 12, 2004